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09/874,314	06/06/2001	Tsuyoshi Inoue	Q64575	6107

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SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
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Washington, DC 20037

EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

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UNITED STATES DEPARTMENT OF COMMERCE
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 01/12/05

Serial Number: 09/874,314
Filing Date: June 6, 2001
Appellant(s): Inoue et al.

Sughrue, Mion, Zinn, Macpeak & Seas
For Appellants

EXAMINER'S ANSWER

MAILED
JAN 26 2005
GROUP 1700

1. This is in response to appellants' Brief on appeal filed November 1, 2004.
2. **(1) Real Party in Interest**
3. A statement identifying the real party in interest is contained in the Brief.
4. **(2) Related Appeals and Interferences**
5. A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the Brief.
6. **(3) Status of Claims**
7. The statement of the status of the claims contained in the Brief is correct.

Art Unit 1771

8. (4) *Status of Amendments After Final*

9. The appellants' statement of the status of amendments after final rejection contained in the Brief is correct.

10. (5) *Summary of Invention*

11. The summary of invention contained in the Brief is correct.

12. GROUND(S) OF REJECTION TO BE REVIEWED ON APPEAL

The Examiner agrees with appellants' characterization of the issues on appeal and further notes that claims 1 and 2 have not been grouped together but are argued individually.

13. (9) *Prior Art of Record*

14. The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,643,676	Dobashi et al.	July 1, 1997
EPA 0273585A1	Exxon Chemical Patents Inc.	July 6, 1988

15.(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1 and 2 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dobashi et al. in view of EP 0273585A1 (EP -585). The primary reference, which is believed to be an English language equivalent of JP-A-6-73352 cited on page 2 of appellants' specification discloses a large number of embodiments

which may be utilized as paint masking adhesive sheets which are suitable for covering automobiles and the like, having on one side thereof a rubber based pressure sensitive adhesive composition which further includes the presence of at least one species of a broad genus of well known tackifiers (note particularly column 9 lines 35-47, as well as the Abstract, column 1 lines 5-9, column 2 lines 26-41, and column 5 lines 8-15). The reference fails, however, to disclose a member of appellants' narrowed Markush grouping which comprises two tackifier subgenuses, one of which is a "hydrogenated aliphatic/aromatic copolymer petroleum resin". Dobashi et al., however, does disclose that the rubber based pressure sensitive adhesive preferably contains a tackifier such as an "aliphatic, aromatic or allcyclic petroleum resin and those modified, for example, by hydrogenation". The secondary reference, EP -585, however, discloses (note particularly the Abstract, page 2 line 25 - page 3 line 16, particularly page 3 lines 5-10) a similar pressure sensitive adhesive composition which teaches that as is well known to one of ordinary skill in the art "the rubbers are generally tackified with the resin", which tackifier resins include petroleum resins such as those characterized as aliphatic/aromatic, and resins made by copolymerization of pure aromatic monomers with olefins",

Art Unit 1771

which the Examiner respectfully submits are inherently hydrogenated, and as such clearly discloses the second member of appellants' Markush grouping. With respect to motivation for the combination, the Examiner believes that one of ordinary skill, aware of the wide variety of tackifiers which are suitable for being incorporated into rubber based pressure sensitive adhesives and further aware of the motivation set forth in EP -585, particularly at page 2, lines 15-18 where it is stated that there would be enhanced process of making advantages as well as improved economic and environmental benefits attained from the use of less solvent would accordingly incorporate at least one member of the aforementioned tackifier subgenus component in place of the closely related subgenus of tackifiers taught in column 9 lines 38-41 of Dobashi et al. and thereby either inherently form the claimed genus of adhesive sheets. With respect to the various ranges of proportions of the tackifier component, it is noted that independent claim 1 contains no limits on the amount of tackifier present, and as regards claim 2 the amount of tackifier present is believed to be easily optimized for its intended end purpose by one of ordinary skill in the art.

With respect to the unrequested Declaration submitted by co-inventor Inoue, the Examiner notes that this has not been

Art Unit 1771

given meaningful weight since what was compared was the no longer relied upon composition of Dobashi et al versus the two solitary examples of the invention, and also note that the Declaration submits only conclusions in its fouling evaluation test, instead of objective evidence which can be readily analyzed by a disinterested viewer.

16.(11) ***Response to Argument***

The Examiner initially notes that appellants' motivation for the combination and their corresponding representative field of prior art are viewed as being extremely narrow in what the Examiner respectfully submits is an extremely well worked area of technology, i.e. rubber based pressure sensitive adhesive coated sheets and tapes, and in which claim 1 is except for the recitation of the tackifier component an extremely broad claim. In a similar vein, appellants' characterization (Brief, page 8, lines 9-11) that there is no disclosed utility for EP -585 clearly ignores the considerable skill of the art pertaining to pressure sensitive adhesive coated sheets and tapes. Appellants further remark (Brief, page 6, top paragraph) that the Examiner has "nor provided any basis for an expectation of success even if the references could properly be combined" is strongly disagreed with in view of the fact that both of the references clearly relate to tackifier containing

Art Unit 1771

rubber based pressure sensitive adhesive sheets and tapes, and the particular subgenuses of tackifiers taught by each reference are extremely closely related, as has been pointed out. In a similar vein, the Examiner strongly contests appellants' statement (Brief, page 7, lines 13-15) that "Dobashi et al. does not suggest the hydrogenated aliphatic/aromatic copolymer petroleum resins as presently claimed , as the Examiner has conceded", which the Examiner respectfully submits he definitely has not conceded. Appellants' remarks (Brief page 10, lines 13-17) that such elements as "solids content, solid removal and environment concerns are not even disclosed in Dobashi et al." ignore the high level of ordinary skill in this environmentally conscious, economic conscious art. Additionally, his remarks (Brief, page 12, first complete paragraph) concerning the fact that Dobashi et al. teaches that the tackifier content for its lightly tacky adhesive sheets should contain only 1-30 parts tackifier by weight per 100 parts of adhesive composition fails to note that this is not far from the lower level of the range taught in EP -585 concerning the amount of tackifier which may be present, and furthermore again totally ignores the level of ordinary skill in the art wherein one would readily be aware of the fact that lightly adhering adhesive sheets such as Dobashi et al. teaches would naturally have lesser amounts of tackifier

Art Unit 1771

than other types of adhesive sheets and tapes which might be designed for other intended usages, and in which the adhesive tapes of EP -585 might well be utilized. Finally, it is again noted that appellants' independent claim 1 contains no ranges of proportions of tackifier.

In summary, the Examiner notes that this invention involves an extremely well known field of technology, i.e. tackified rubber based pressure sensitive adhesive sheets and tapes wherein all appellants have done is to substitute one subgenus of one of the common ingredients, tackifiers, for an extremely closely related tackifier subgenus taught by another rubber based pressure sensitive adhesive tape and/or sheet teaching reference and by doing so have achieved the expected end result. Unfortunately, such an invention is not believed worthy of patentable protection.

17. For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

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Serial No. 09/874,314

-8-

Art Unit 1771

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